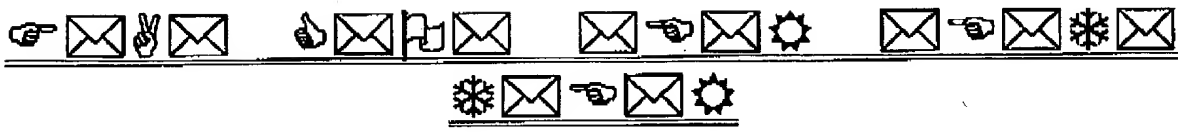
1743



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Hideki Itaya, Jason Dominik Hool, Javier Urena, Fredrick Spears, Osamu Ohno and Kantaro Maruoka	PATENT
SERIAL NUMBER: **09/849,857**	ART UNIT NO.: ~~1785~~ 1743
FILED: **May 3, 2001**	EXAMINER: **To be determined**
FOR: **A DIAGNOSTIC INSTRUMENT WITH OVERLAPPING CAROUSELS**	ATTORNEY DOCKET NO.: **HCDI1785**

San Jose, California
April 23, 2004

I hereby certify that this Response to Restriction Requirement and the documents referred to as enclosed therein are being deposited to either via fax to (703) 872-9306 or with the United States Postal Service on April 23, 2004 in an envelope addressed to Box Non-Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Douglas A. Chaikin
Typed or printed name of person mailing paper or fee

Douglas A. Chaikin
Signature of person mailing paper

RESPONSE TO EXAMINER'S REQUIREMENT OF RESTRICTION - 35 U.S.C. § 121

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Responsive to the Examiner's Requirement for election of species in the above referenced matter, mailed March 26, 2004, please enter the following Response and request for reconsideration of the requirement.

R*E*M*A*R*K*S

Prior to reading further, the Examiner is requested to change the file name from HITA1785 to HCDI1785. Such request is urgently needed so that all parties hereto can accurately keep track of this case for docketing and other purposes. Applicant

apologizes for the error made in the original and subsequent filings in this case. At those times a new person was employed by the undersigned and unfamiliar with the importance of correct docket number procedure. The undersigned has taken all the appropriate steps to correct this problem and can assure the Office that it will not happen again.

ELECTION OF SPECIES

Responsive to the Examiner's requirement under 35 U.S.C. §121 that a single disclosed species be elected for prosecution on the merits, Applicants elect to prosecute the invention of Species I, Claims 1-18. Accordingly, Applicants at this time cancel the remaining claims, Claims 19-21 from consideration as being drawn to non-elected species. However, Applicants regard this withdrawal as being without prejudice pending the Examiner's consideration of the traversal that follows herein.

TRAVERSAL OF REQUIREMENT FOR ELECTION OF SPECIES

Applicants respectfully request reconsideration of the instant requirement for election of species. Applicants hereby preserve the instant request for reconsideration for subsequent petition and appeal. The Examiner states that there are two species presented in the above captioned patent application which are patentably distinct from one another. The Examiner takes the position that the Application contains claims directed to the following patentably distinct species of the claimed invention:

Species or Invention I, Claims 1-18, is drawn to an apparatus for the invention, "classified in class 422, subclass 64"; while

Species or Invention II, Claims 19 – 21, is drawn to a method for the disclosed invention, "classified in class 436, subclass 180".

The Examiner goes on to state that two inventions are related as a process and an apparatus. The Examiner states that the process can be practiced by another materially different apparatus or by hand and that the apparatus can be used to practice another and materially different process.

The Examiner concludes "because these inventions are distinct and have

acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper." All of that may well be true, but it is not the test for a proper restriction requirement. The test is as follows:

Section 803 of the MPEP states:

> If the search and examination of an entire application can be made without serious burden, the examiner ***must*** examine it on the merits, even though it includes claims to distinct or independent inventions. (Emphasis supplied)

MPEP 803, Rev. 2, July 1996 at 800-3. The same section further states:

> There are two criteria for a proper requirement for restriction between patentably distinct inventions:
>
> (1) The inventions must be independent (see MPEP § 802.01, §806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - §806.05(i)); and
>
> (2) There must be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 806.04(a)-(j), § 808.01(a) and §808.02).

MPEP §803, *supra* at 800-3. It is the duty of the Office to allow an inventor to embrace in one application contrivances, however distinct, which mutually contribute to produce a unitary result. *Ex parte Kuh,* 1876 C.D. 190 (Comm'r). Applicants submit that the embodiments of the present Application all comprise a single inventive concept and all operate to produce the objects of the invention. Certainly the admission by the Examiner to begin with, namely that the species are related as "process and apparatus" all but admits this fact.

As for the second criterion for restriction that must be shown by the Examiner -- that of a serious burden upon the Office – MPEP § 803 states that examiners must provide reasons and/or examples to support conclusions. The Examiner has not even begun to address this issue. Merely because there is shown to be separate classification does not conclusively bar the examination of a unitary invention and a single examination. Indeed, the Examiner has not even stated that such a burden is perceived.

RESPONSE TO RESTRICTION REQUIREMENT
ATTORNEY DOCKET NO.: HCDI1785 **April 23, 2004**

35 U.S.C. §121 authorizes the Commissioner to restrict an invention only where two or more independent and distinct inventions are claimed in one application. Applicants agree with the Examiner's conclusion that two or more inventions are present which are patentable over each other. However, the Examiner has not shown that the embodiments cannot be treated as comprising a single inventive concept, nor that a serious burden would result unless restriction were required. Therefore, the propriety of the instant requirement for election of species has not been established.

Withdrawal of the requirement for restriction will not cause the Examiner to encounter serious burden. The present restriction requirement is not justified under either 35 U.S.C. §121, 37 C.F.R. §141 et seq., or MPEP Chapter 800. Withdrawal of the instant requirement for restriction is appropriate. Accordingly, Applicants respectfully request that the requirement be withdrawn and that the entire Application be examined on the merits.

Respectfully submitted

PENINSULA IP GROUP
A Professional Law Corporation

Douglas A. Chaikin
Reg. No. 29,140
2290 North First Street, Suite 101
San Jose, California 95131
Tel: (408) 965-4001